

REMARKS

New Claim 51 specifies that the packaging film consists of an outer film of polyethylene terephthalate (PET) forming the outside of the bag-type package and an inner film of polyethylene (PE) forming the inside of the bag-type package, and further that the inner film is coated with an adhesive layer based on polyurethane (PU) and is bonded to the outer film. These additional features are disclosed in the specification of page 3, lines 20 to 24.

Non-obviousness of PET/PE film having lines of perforations in the PE film.

The lines of perforations serving as guidelines on both sides of a tear line propagating in the packaging film starting from the tip of a notch. Upon tearing open the package, the tear line ideally leads to a separation of the film in a straight line over the whole width of the packaging. In practice it often happens that upon careful tearing open of the packaging in the direction of the lines of perforations the tear line follows one of the lines of perforations over the entire width of the packaging. However, if the part of the packaging to be removed is torn away in a tear direction deviating from the direction of the lines of perforations, e.g., diagonally upward, the tear line following one line of perforations at the beginning suddenly propagates uncontrollable outside of the line of perforations and often leads to an incomplete opening of the packaging.

Experiments made with different multilayer packaging films having lines of perforations have shown that the development of the tear line apparently also depends in which layer of a multilayer packaging film the lines of perforations are arranged. It was found that with a packaging film consisting of a PET film

bonded to a PE film by an adhesive based on PU, upon tearing in a direction diagonally to the direction of the lines of perforations a tear induced between two parallel lines of perforations follows more frequently and over a longer distance one of the two lines of perforations, if the lines of perforations are arranged in the PE film.

The different development of tear depending on the arrangement of the lines of perforations in the PET film and the PE film, respectively, is an unexpected effect which can not be derived from the applied prior art references, or combinations thereof.

Besides the errors in and unsustainability of the two obviousness rejections, as shown in applicants' amendment, the two obviousness rejections are defective on their face and for failure to follow Patent Office policy and the requirements of the Supreme Court's Graham decision [i.e., 383 U.S.1, 148 USPQ 459 (1966)].

Section 2141 of the M.P.E.P. (Rev. 2) states:

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

(A) Determining the scope and contents of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue;

- and (C) Resolving the level of ordinary skill in the pertinent art;
(D) Evaluating evidence of secondary considerations.”

[Emphasis Supplied]

Nowhere has the Examiner factually determined in the record the level of ordinary skill in the art. Accordingly, the Examiner has not made a valid obviousness rejection or a valid factual showing of prima facie obviousness.

The Board of Appeal’s (nonprecedential) decision of *Ex parte Leu et al.* states:

“Rejections based on § 103(a) must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the Appellants’ disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Productions Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988),”
[Emphasis supplied] [Page 7, lines 9 to 15].

Section 2141.03 of the M.P.E.P. (Rev. 2) states:

“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.’ *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must

ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984)."

Since the Examiner has not factually determined in the record the level of ordinary skill in the art, there cannot be a *prima facie* showing of obviousness. The burden of proof is still on the Examiner. Section 2144.08, II, of the M.P.E.P. states:

"A proper obviousness analysis involves a three-step process. First, Office personnel should establish a *prima facie* case of unpatentability considering the factors set out by the Supreme Court in *Graham v. John Deere*. See, e.g., *In re Bell*, 991 F.2d 781, 783 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ('The PTO bears the burden of establishing a case of *prima facie* obviousness.'); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham v. John Deere Co.*, 383 U.S. 1; 17-18 (1966), requires that to make out a case of obviousness, one must:

(A) determine the scope and contents of the prior art;

(B) ascertain the differences between the prior art and the claims in issue;

(C) determine the level of skill in the pertinent art; and

(D) evaluate any evidence of secondary considerations. If a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case.” [Emphasis Supplied]

The Board of Appeal’s (nonprecedential) decision of *Ex parte Yim et al.*, (Appeal No. 2005-2013), states:

“To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention.” [Page 3, lines 16 to 19]

The Examiner has not factually determined in the record the ordinary level of skill in the art so the Examiner does not know who is, or anything about, one ordinarily skilled in the art. Accordingly, even where one ordinarily skilled in the art is asserted by the Examiner to have motivation, the Examiner’s position is clearly defective because the Examiner does not know anything about one ordinarily skilled in art. The Examiner has not factually established in the record any *prima facie* showing of obviousness of appellants’ claimed invention.

The two obvious rejections fail on their face.

Reconsideration, reexamination and allowance of the claims is
requested.

Respectfully submitted,

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Date

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